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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/512,140

10/22/2004

Richard Hugh Clark

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01/05/2009

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EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

01/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/512,140	Applicant(s) CLARK ET AL.	
	Examiner Ellen M. McAvoy	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submissions: amendments to the claims and remarks, filed on 23 October 2008, have been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berlowitz et al (6,663,767).

Applicants' arguments filed 23 October 2008 have been fully considered but they are not persuasive. As previously set forth, Berlowitz et al ["Berlowitz"] disclose a diesel fuel blended fuel composition which comprises an undercut conventional diesel fuel and a Fischer-Tropsch derived diesel fuel in amounts ranging from 5 to 90 vol. % of Fischer-Tropsch derived distillate, and 90 to 5 vol. % petroleum distillate. See the claims. Berlowitz teaches that the blended fuel demonstrates better than expected emissions and reduced sulfur content when used in a diesel engine. See column 2, lines 17-63. The Fischer-Tropsch derived diesel fuel is set forth in

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columns 3-4 wherein the Fischer-Tropsch derived hydrocarbon distillate has a T95 of at least 600°F, more preferably the Fischer-Tropsch derived distillate has an initial boiling point of at least 300°F and a T95 of at least 650°F, even more preferably an initial boiling point of at least 320°F and a T95 of at least 700°F to 750° F. See lines 49-54 in column 4. The examiner is of the position that the Fischer-Tropsch derived hydrocarbon distillate of Berlowitz meets the limitations of the Fischer-Tropsch derived gas oil of the claims. The blended fuel composition was subjected to engine testing wherein the blended diesel fuel was compared to conventional petroleum diesel fuels. Berlowitz teaches that significantly lower emissions and particulate matter were produced from the diesel fuel blend when compared to two different conventional diesel fuels. See column 6, line 59 to column 7, line 40. The examiner is of the position that Berlowitz meets the limitations of the above rejected independent method claims 12 and 24, and meets the limitations of independent diesel fuel composition claim 36.

In response applicants presented new independent claims 12 and 24 which are drawn towards the method of reducing combustion related deposits in a diesel engine and argued that Berlowitz does not disclose a method of reducing combustion related deposits in a diesel engine (i.e., clean engine deposits). This is not deemed to be persuasive because the method of independent claim 12 comprises the step of “introducing into a combustion chamber of the diesel engine a fuel blend comprising” which is clearly taught by Berlowitz as set forth above. Further, the preamble language in independent claims 12 and 24 “of reducing combustion related deposits in a diesel engine” is not accorded any patentable weight since the method of adding a diesel fuel blend containing a Fischer-Tropsch derived fuel to a diesel engine is taught by the prior art. Although reducing engine deposits is not specifically set forth in Berlowitz, reduction of

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particulate matter is briefly discussed in column 7, lines 37-40, and it has been held that the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. See *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342,1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Further the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Claim Rejections - 35 USC § 103

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berlowitz et al (6,663,767) in combination with Bacha et al (6,776,897).

Berlowitz et al ["Berlowitz"] is relied on as outlined above. Applicants' invention may differ in dependent claim 42 by adding a conventional additive, namely a detergent, to the diesel fuel blend which is not taught in Berlowitz. However, Bacha et al ["Bacha"] is added to teach that diesel fuel compositions containing Fischer-Tropsch derived diesel fuels may comprise conventional additives such as detergents. See column 5, line 48 to column 6, line 66. Having the prior art references before the inventors at the time the invention was made it would have been obvious to the skilled artisan to have added a detergent to the diesel fuel blended composition of Berlowitz if its known imparted property was so desired.

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This is a RCE of applicants' earlier Application No. 10/512,140. All claims are drawn to essentially the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ellen M McAvoy/

Ellen M McAvoy
Primary Examiner
Art Unit 1797

EMcAvoy
January 4, 2009